

Appl. No. 09/444,359
Amdt. dated February 17, 2004
Reply to Office Action of November 17, 2003

PATENT

REMARKS/ARGUMENTS

The Applicants appreciate the Examiner's decision to reopen prosecution in this matter.

Claims 1-42 are pending in this application. No claims have been amended, added, or cancelled. Hence, claims 1-42 remain pending. Reconsideration of the subject application as amended is respectfully requested.

Claims 1-26, 30-34, 37-39 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,230,017 to Andersson, *et al.* (hereinafter "Andersson"), and in view of the cited portions of U.S. Patent No. 6,577,857 to Rodriguez, *et al.* (hereinafter "Rodriguez").

Claims 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson, in view of Rodriguez and further in view of the cited portions of U.S. Patent No. 6,397,040 to Titmuss, *et al.* (hereinafter "Titmus").

Claims 28-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson, in view of Rodriguez and further in view of the cited portions of U.S. Patent No. 6,522,888 to Garceran, *et al.* (hereinafter "Garceran").

Claims 35-36 and 40-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Andersson, in view of Rodriguez and further in view of the cited portions of U.S. Patent No. 6,212,377 to Dufour, *et al.* (hereinafter "Dufour").

Claim Rejections Under 35 U.S.C. § 103(a)

The Applicants respectfully traverse the rejection of all claims because the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

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(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action has not shown that the prior art teaches or suggests all the claim limitations, and the office action does not cite a reference that teaches or suggests a motivation to combine reference teachings.

With respect to claim 1, the office action correctly states that Anderson does not teach, "receiving from the mobile subscriber user-defined, location-dependent rules associated with at least one telephone service subscribed to by the mobile subscriber." The office action goes on to say that Rodriguez teaches this at col. 7, lines 27-43. With this, the applicants disagree. At that location, Rodriguez teaches an access restriction profile. There is no teaching, however, that the access restriction profile is "user-defined." In fact, it is not even clear that the access profile is "location-dependent." Thus, the office action has not satisfied the third prong of the test because the cited references do not teach all the claim limitations.

Further, the office action does not cite a reference in the prior art that provides the necessary motivation or suggestion to combine the teachings of Anderson with those of Rodriguez to achieve the Applicant's claimed invention. The Applicants note that,

[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

(MPEP § 2143.01) However,

[t]he examiner may take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being well-known in the art. ... If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. ... If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner.

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(MPEP § 2144.03, emphasis added, citing 37 CFR §1.104(d)(2)) Because no reference is cited that provides the teaching, suggestion, or motivation to combine the references, the Applicants assume the office action is relying on facts within the personal knowledge of the Examiner. The Applicants, therefore, respectfully traverse the rejection and request either an express showing of documentary proof, or an affidavit specifically stating the facts within the personal knowledge of the Examiner, as required by 37 CFR §1.104(d)(2).

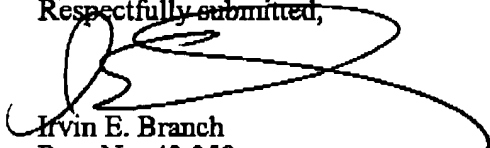
For all of the above reasons, the Applicants believe that claim 1 is allowable over the cited references. Claim 17 includes a similar limitation and is believed to be allowable for similar reasons. Further, since the remaining claims depend from one of these independent claims, the Applicants believe that the remaining claims also are patentable.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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